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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
LEE, TOMMY D	
ART UNIT	**PAPER NUMBER**
2624	

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/459,202	MORI, YUKIKAZU	
	Examiner	Art Unit	
	Thomas D. Lee	2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 June 2005 and 22 September 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-33* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 22, 2005 has been entered.

Response to Amendment

2. This Office action is responsive to applicant's amendment filed June 23, 2005. Claims 1-33 are pending.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1, 2, 5, 6, 9-14, 18-20, 21/(9-14, 18-20), 22, 25/14 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,052,445 (Bashoura et al.) in view of U.S. Patent 6,437,871 (Yuki).

Regarding claim 1, Bashoura et al. teach a network facsimile device for communicating in at least one of a plurality communication modes for transmitting designated image information to a designated destination, said device comprising: input means for operator input of information identifying a plurality of destination addresses, including for each destination a plurality of address information respectively

corresponding to said plurality of communication modes, and for designating one address among said plurality addresses to which the document image information is to be transmitted (column 3, line 63 - column 4, line 7; column 4, lines 15-20 (programming a table to store information inherently requires an operator to input the information intended to be stored)); and address information registering means for registering a plurality of address information respectively corresponding to said plurality of communication modes, input by the operator through said input means, for each destination (column 4, lines 8-20), wherein one of the plurality of destinations and one of said plurality of communication modes are selected by designating said one address among said plurality of addresses using said input means (in response to a dialed telephone number, a communication mode is selected based on whether an address corresponding to a particular mode is stored (column 4, line 39 – column 5, line 13), and thus a destination (associated with the dialed telephone number) and communication mode (IP or e-mail address) is selected by designating an address (the dialed telephone number)).

Scanner means for scanning a document and outputting document image information is provided in a local fax machine 1 connected to fax director 3 (Fig. 1). While the scanner means, input means and address information registering means are not located in a single device, such a limitation is disclosed in Yuki. Scanner means 2, input means (panel operation portion 1) and address information registering means (memory portion 5) are located within the facsimile apparatus shown in Fig. 1 of Yuki (column 3, lines 29-53). Since all of the components are provided in a single device,

portability is enhanced; and a single device may be contained in a smaller area, thereby saving floor space. Therefore, it would have been obvious for one of ordinary skill in the art to modify the teaching of Bashoura et al. by combining the local fax machine, fax director and local computer in a single housing, such as disclosed in Yuki.

Bashoura et al. do not teach display means, wherein, when said input means is repeatedly operated at the time of designating the address, a plurality of address information registered are changed over and viewed on said display means in order, as recited in claim 2, or one-touch dial means for enabling a large number of addresses to be registered and to designate the one address by operating the one-touch dial means, as recited in claims 5 and 6. Yuki teaches a facsimile apparatus having a display means for displaying a plurality of registered address information stored in one-touch dial memory (column 5, lines 51-57; column 6, lines 54-59). When one of the destinations is specified by operation of the panel operation portion, a copy operation begins (column 5, lines 56-60; column 6, lines 59-64). By providing a one-touch dial operation, a user may save time in dialing numbers that are frequently used, since only one key corresponding to the telephone number or IP address need be pressed. Therefore, it would have been obvious for one of ordinary skill in the art to modify the teaching of Bashoura et al., by providing a one-touch dial memory such as taught by Yuki. Repeated operation of input means is merely a scrolling operation for changing addresses or modes of operation on a display, which is well known in the art. Regarding claim 9, Bashoura et al. teach a network facsimile device for communicating in at least one of a plurality of communication modes for transmitting designated image

information to a designated destination, said device comprising: Internet image information communicating means for performing communication of image information through the Internet (column 2, lines 51-56); and public network image information communication means for performing communication of the image information through a public network, wherein said Internet image information communication means and said public network image information communicating means communicate information to a plurality of designated destinations (column 2, lines 56-61); input means for inputting information identifying a plurality of destination addresses, including for each destination a plurality of address information respectively corresponding to said plurality of communication modes, and for designating one address among said plurality of addresses to which the document image information is to be transmitted (column 3, line 63- column 4, line 7; column 4, lines 15-20 (programming a table to store information inherently requires an operator to input the information intended to be stored)); and address information registering means for registering a plurality of address information respectively corresponding to said Internet image information communicating means and public network image information communicating means, for each designated destination (column 4, lines 8-20), wherein one of the plurality of destinations and one of said plurality of communication modes are selected by designating said one address among said plurality of addresses using said input means (in response to a dialed telephone number, a communication mode is selected based on whether an address corresponding to a particular mode is stored (column 4, line 39 – column 5, line 13), and thus a destination (associated with the dialed telephone number) and communication

mode (IP or e-mail address) is selected by designating an address (the dialed telephone number)).

As mentioned above with respect to claim 1, it would have been obvious for one of ordinary skill in the art to modify the teaching of Bashoura et al. by combining the local fax machine, fax director and local computer in a single housing, such as disclosed in Yuki.

Regarding claims 10 and 11, Bashoura et al. teach a network facsimile device for communicating in at least one of a plurality of communication modes for transmitting designated image information to a designated destination, said device comprising: electronic-mail type Internet image information communicating means for performing communication of the image information through the Internet by use of electronic mail (column 4, lines 27-38); real-time type Internet image information communicating means for performing communication of the image information through said Internet in real time (column 4, lines 21-26, 34-38); and public network image information communicating means for performing communication of the image information through a public network (column 2, lines 56-61), wherein any one of said electronic-mail type Internet image information communicating means, said real-time type Internet image information communicating means, and said public network image information communicating means communicates information to a plurality of designated destinations (column 4, line 43 – column 5, line 13); and input means for inputting information identifying a plurality of destination addresses, including for each destination a plurality of address information respectively corresponding to said plurality of

communication modes, and for designating one address among said plurality of addresses (column 3, line 63 – column 4, line 7; column 4, lines 15-20 (programming a table to store information inherently requires an operator to input the information intended to be stored)); and address information registering means for registering a plurality of address information respectively corresponding to said electronic-mail type Internet image information communicating means, said real-time type Internet image information communicating means, and said public network image information communicating means, for each designated destination (column 4, lines 8-20), wherein one of the plurality of destinations and one of said plurality of communication modes are selected by designating said one address among said plurality of addresses using said input means (in response to a dialed telephone number, a communication mode is selected based on whether an address corresponding to a particular mode is stored (column 4, line 39 – column 5, line 13), and thus a destination (associated with the dialed telephone number) and communication mode (IP or e-mail address) is selected by designating an address (the dialed telephone number)). Said plurality of registered address information include an e-mail address for use by said electronic-mail type Internet image information communicating means, an IP address for use by said real-time type Internet image information communicating means, and a telephone number for use by said public network image information communicating means (Fig. 4).

Scanner means for scanning a document and outputting document image information is provided in a local fax machine 1 connected to fax director 3 (Fig. 1). While the scanner means, input means and address information registering means are

not located in a single device, such a limitation is disclosed in Yuki. Scanner means 2, input means (panel operation portion 1) and address information registering means (memory portion 5) are located within the facsimile apparatus shown in Fig. 1 of Yuki (column 3, lines 29-53). Since all of the components are provided in a single device, portability is enhanced; and a single device may be contained in a smaller area, thereby saving floor space. Therefore, it would have been obvious for one of ordinary skill in the art to modify the teaching of Bashoura et al. by combining the local fax machine, fax director and local computer in a single housing, such as disclosed in Yuki.

As mentioned above with respect to claim 1, it would have been obvious for one of ordinary skill in the art to modify the teaching of Bashoura et al. by combining the local fax machine, fax director and local computer in a single housing, such as disclosed in Yuki.

Claims 12-14 each recite the display means of claim 2, and thus are rejected for the reasons set forth above.

As mentioned above with respect to claim 2, Bashoura et al. do not teach repeatedly operating the same key at the time of designating the address, thereby changing over and selecting, in order, a plurality of address information registered in said key (claims 18-20 do not recite display means, and is thus not rejected in view of Yuki). However, repeated operation of input means is merely a scrolling operation for changing addresses or modes of operation on a display, which is well known in the art. Providing a key for changing and selecting address information in order would have been an obvious modification for one of ordinary skill in the art, for it allows a user to

save time in changing address information. Accordingly, claims 18-20 are rejected for the reasons set forth above with respect to claim 2.

Claims 21 and 25 each recite the one-touch dial means of claims 5 and 6, and thus are rejected for the reasons set forth above.

Claim 22 recites the features of above-rejected claim 10, and further recites the repeated operation of input means similarly recited in claim 20, and is thus rejected, for the reasons set forth above.

Regarding claim 32, the one-touch dial means disclosed in Yuki, as mentioned above with respect to claims 5 and 6, enables operator use of said input means to designate one of the addresses registered for a destination to which the document image information is to be transmitted, and the document image information is transmitted to the designated address.

5. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bashoura et al.

Claim 26 is a method claim corresponding to above-rejected apparatus claim 22. The method steps of the claim are either disclosed or would have been obvious in view of Bashoura et al. (note above rejections of claims 10 and 20, as well as claim 22). Note that the method claim does not require the scanning operation as well as the other operations to be performed in a single device, and thus the step of scanning a document and providing document image information based on the scanned document is performed by the local fax machine of Bashoura et al. (scanning is a standard feature of fax machines).

6. Claims 31 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bashoura et al. as applied to claim 26 above, and further in view of Yuki.

As mentioned above, claim 31 recites the one-touch dial means of claims 5 and 6, and thus is rejected for the reasons set forth above. The one-touch dial means enables operator designation of one of the mail address, the IP address and the telephone number registered for a destination associated with said key; and transmitting the document image information to the address designated by the operator.

7. Claims 3, 4, 7, 8, 15-17, 21/(15-17), 23, 24, 25/(15, 23, 24), 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bashoura et al. in view of Yuki and U.S. Patent 5,381,527 (Inniss et al.).

Regarding claim 3, Bashoura et al. do not teach setting each of a plurality of address information registered by said address information registration means with a transmission priority indicating an order in which communication modes are to be used for transmitting the designated image information to the designated destination, as recited in claim 3. Inniss et al. teach a system for efficient message distribution, wherein methods of communicating messages are prioritized (column 3, line 33 – column 4, line 5). By prioritizing the communication modes, the transmitting of any type of message may be performed with greater efficiency. A user may know which destinations are capable of operating under certain modes of communication, and may prioritize based on such knowledge so as to avoid possible errors in transmission. Thus, it would have been obvious for one of ordinary skill in the art to modify the

teaching of Bashoura et al. by providing means for setting a priority order for communicating messages, such as taught by Inniss et al.

Claim 4 further recites repeatedly operating the same key at the time of selecting the address, thereby changing over and selecting plural address information registered on said key in accordance with said transmission priority order. As mentioned above with respect to claim 2, repeated operation of input means is merely a scrolling operation for changing addresses or modes of operation on a display, which is well known in the art. Providing a key for changing and selecting address information according to a priority order would have been an obvious modification for one of ordinary skill in the art, for it allows a user to save time in changing priorities for each destination.

Claims 7 and 8 each recite the one-touch dial means of claims 5 and 6. As mentioned above, Yuki teaches a facsimile apparatus having a display means for displaying a plurality of registered address information stored in one-touch dial memory (column 5, lines 51-57; column 6, lines 54-59). When one of the destinations is specified by operation of the panel operation portion, a copy operation begins (column 5, lines 56-60; column 6, lines 59-64). By providing a one-touch dial operation, a user may save time in dialing numbers that are frequently used, since only one key corresponding to the telephone number or IP address need be pressed. Therefore, it would have been obvious for one of ordinary skill in the art to modify the combined teaching of Bashoura et al. and Inniss et al., by providing a one-touch dial memory such as taught by Yuki.

Claims 15-17 each recite the setting means of claim 3, and are thus rejected for the reasons set forth above.

As mentioned above, claims 21 and 25 recite the one-touch dial means of claims 5 and 6, and thus are rejected for the reasons set forth above.

Claim 23 recites the features of above-rejected claim 10, and further recites registering respective transmission priority orders for each of said mail address, said IP address, and said telephone number; wherein either one of said electronic-mail type Internet image information communicating means, said real-time type Internet image information communication means, and said public network information communicating means is selected in accordance with the transmission priority order respectively registered with said mail address, said IP address, and said telephone number, for image information transmission to the address selected by operation of said input means. As mentioned above with respect to claim 3, Inniss et al. teach a system for efficient message distribution, wherein methods of communicating messages are prioritized (column 3, line 33 – column 4, line 5). By prioritizing the communication modes, the transmitting of any type of message may be performed with greater efficiency. A user may know which destinations are capable of operating under certain modes of communication, and may prioritize based on such knowledge so as to avoid possible errors in transmission. Thus, it would have been obvious for one of ordinary skill in the art to modify the teaching of Bashoura et al. and Yuki by providing means for setting a priority order for communicating messages, such as taught by Inniss et al.

Claim 24 recites most of the features of claim 23, and further recites repeated operation of input means, thereby changing over and selecting plural addresses in accordance with a transmission priority order. As mentioned above with respect to claim 4, providing a key for changing and selecting address information according to a priority order would have been a obvious modification for one of ordinary skill in the art, for it allows a user to save time in changing priorities for each destination. Accordingly, device claim 24, as well as corresponding method claim 28, is rejected.

Claims 29 and 30 each also recite the one-touch dial means of claims 5 and 6, and thus are rejected as well, for the reasons set forth above.

8. Claims 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bashoura et al. in view of Inniss et al.

Claims 27 and 28 are method claims corresponding to above-rejected apparatus claims 23 and 24, respectively. The method steps of the claims are either disclosed or would have been obvious in view of Bashoura et al. and Inniss et al. (note above rejections of claim as well as claims 23 and 24). Note that the method claims do not require the scanning operation as well as the other operations to be performed in a single device, and thus the step of scanning a document and providing document image information based on the scanned document is performed by the local fax machine of Bashoura et al. (scanning is a standard feature of fax machines).

Response to Arguments

9. Applicant's arguments filed in response to the prior rejection of the claims as set forth in the Office action dated May 20, 2005 have been fully considered but they are not persuasive.

Regarding Bashoura, applicant asserts that "[t]he rerouting of the transmission through the Internet is transparent to the user. The user is not presented with a choice of plural communication modes for selection by the user" (amendment, page 20, lines 9-18). However, the claims recite selection of a destination and a communication mode "by designating said one address among said plurality of addresses using said input means." The user does not actively choose a communication mode; the user chooses an address, and the communication mode is selected on the basis of that choice. This limitation reads on Bashoura, as set forth above.

Regarding Yuki, applicant asserts that Yuki "does not disclose or suggest a network facsimile device including input means for operator input of information including a plurality of destination addresses, including for each destination a plurality of address information respectively corresponding to the plurality of communication modes, and for designating one address among the plurality of addresses to which the document image information is to be transmitted, wherein one of the plurality of destinations and one of the plurality of communication modes are selected by designating the one address among the plurality of addresses using the input means, as provided by the claimed invention of this application" (amendment, page 21, lines 3-10).

Applicant does not, however, provide any evidence supporting such an allegation. This limitation, as set forth above, is disclosed in Bashoura.

Regarding Inniss, applicant asserts that there is no disclosure or suggestion "of a network facsimile device which comprises (a) scanner means which scans a document and generates document image information corresponding to the scanned document (b) input means for operator input of information identifying a plurality of destination addresses, including for each destination a plurality of address information respectively corresponding to the plurality of communication modes. and for designating one address among the plurality of addresses to which the document image information is to be transmitted. (c) wherein one of the plurality of destinations and one of the plurality of communication modes are selected by designating the one address among the plurality of addresses using the input means, as provided by the claimed invention of this application" (amendment, page 21, line 15 – page 22, line 1). Once again, applicant does not provide any evidence supporting this allegation. The claimed limitations are suggested in the combined prior art, as set forth above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas D. Lee whose telephone number is (571) 272-7436. The examiner can normally be reached on Monday-Friday (7:30-5:00), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thomas D. Lee
Primary Examiner
Art Unit 2624

tdl
September 28, 2005